REMARKS/ARGUMENTS

Reconsideration and allowance of the above-identified application are respectfully requested. No claims are amended herein. Claims 18-43 remain pending in the application.

At the outset, Applicants request that the Examiner recuse himself from this case, and allow another Examiner to continue prosecution. Applicants lengthy and unduly burdensome prosecution leading up to the Panel Decision of August 31, 2007 withdrawing the Examiner's rejection has resulted in yet another office action containing mainly nonsensical rejections that evidence a clear lack of understanding of the invention, despite numerous attempts to educate the Examiner. Applicants are practicing the invention, and more to the point, industry appreciates the advantage of Applicants invention as shown in the attached news articles detailing the use of Applicants' invention by the State Democratic Party in the New Mexico Democratic primary election (see Exhibit A). Applicants deserve a fair opportunity at patent protection, and they are not receiving that fair opportunity with this Examiner.

Turning to the individual objections and rejections contained in the office action, Applicants comment as follows. The Examiner objected to dependent claims 25-34 and 36-43 because of an alleged informality in the claim form "A system as in claim . . ." There is absolutely no basis for such an objection, and the dependent claim form "A . . . as in . . ." is acceptable so long as it references a prior claim, which each dependent claim does. The Examiner's attention is directed to 37 CFR §1.75(c), which recites "[c]laims in

dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim." There is no suggestion by the Examiner that claims 25-34 or 36-43 lack a reference to a prior claim, and indeed each claim contains an explicit reference to a single prior claim. Accordingly, since under Rule 75, the dependent claims are interpreted to include all of the limitations of the base claims, the Examiner's suggestion that the "as in" language leaves in question whether the base claim limitations are incorporated into the dependent claim is without merit. Reference is also made to MPEP §608.01(n) which provides examples of ***proper*** dependent claims in multiple dependent form. The examples given in MPEP §608.01(n)(I)(A) (Acceptable Multiple Dependent Claim Wording) are ***all given in the form "A*** gadget ***according to*** ..." or "***A*** gadget ***as in***..." Not a single example is provided in the Examiner's suggested form ("**The** gadget **of** claim [x]"). Surely, if multiple dependent claims can be of the form "A gadget as in [base claims]" then Applicants' single dependent claims are proper. The dependent claims incorporate each limitation of the referenced base claims, and accordingly, the objection must be withdrawn.

Next the Examiner rejects claims 35-43 under 35 U.S.C. §112(1), as failing to comply with the written description requirement. The Examiner alleges that the claims directed to "a computer readable medium of instructions . . ." contain subject matter which was not adequately described in the specification. The Examiner is reminded that the claims ***are a part of the specification***. And accordingly, the claimed computer readable medium of instructions is described in the specification. Under MPEP §2161, USPTO personnel are ***required*** to establish ***on the record*** a reasonable basis for questioning the adequacy of the disclosure to enable a person of ordinary skill in the art

to make and use the claimed invention without resorting to *undue experimentation.* The Examiner has not made any such assertion, but rather simply states that the claimed "computer readable medium of instructions" is not adequately described. Furthermore, the Examiner would be unable to establish the required reasonable basis, since the functional steps performed by the claimed computer readable medium of instructions are adequately described. The Examiner has essentially admitted the adequacy of the disclosure, since the corresponding method claims are not rejected under 35 U.S.C. §112(1). The functional block diagrams of FIGS. 1-3 combined with the exemplary screenshots of FIGS. 4-5 and the related written description provide more than enough description to enable one of ordinary skill in the art to make the claimed "computer readable medium of instructions" without undue experimentation. Accordingly, since this rejection is without basis, it must be withdrawn.

The Examiner next rejects claims 35-43 under 35 U.S.C. §101 as being directed to non-statutory subject matter. This is essentially a tweaked version of the rejection withdrawn in the Panel Decision of August 31, 2007. However, the Examiner adds an inference that somehow a lack of description of a "computer readable medium of instructions" in the specification (as discussed above), renders a computer readable medium of instructions as non-statutory subject matter. As the Panel made clear by their repudiation of the Examiner's prior §101 rejection, the claimed "computer readable medium of instructions" is directed to proper statutory subject matter. Whether or not the computer readable medium of instructions is described in the specification has absolutely no bearing on whether a computer readable medium of instructions is patentable subject matter. Furthermore, the adequacy of the written description was addressed above, and

need not be repeated here. Since this rejection was explicitly overturned by the Panel Decision of August 31, 2007, this rejection must be withdrawn.

The Examiner has rejected claims 18-43 under 35 U.S.C. §103(a) as being unpatentable over the oft-cited McClure patent in view of newly cited U.S. Patent No. 6,081,793 to Challener et al. Since McClure has been discussed at length in numerous previous responses, the Examiner is directed to the prior prosecution history for the many reasons McClure fails to teach or suggest claimed features of at least independent claims 18, 24 and 35. The Panel Decision specifically withdrew the Examiner's improper rejection based on the McClure patent. Accordingly, it is exceedingly improper and burdensome on the Applicants for the Examiner to rely primarily on this reference once again. Furthermore, as discussed in more detail below, Challener adds nothing to the teaching of McClure, and both references taken together fail to teach or suggest the claimed features of at least independent claims 18, 24 and 35.

Challener deals mainly with *electronic voting*, and details methods of *encrypting* various vote-related data to ensure secure, tamper-free transmittal of ballots and vote data between voters and journal servers. Challener briefly describes how paper ballots could also be used (Col. 6, Line 65- Col. 7, Line 37). However, the description of paper ballots does not teach or describe "scanning said plurality of voted ballots and *generating computer readable visual representations of each of said ballots*". At most, Challener describes generating *vote-data* from machine-readable paper ballots (either pen or pencil marks inside machine readable "dots" like an SAT exam, or machine-readable holes removed from the paper ballot by a mechanical stylus, as in the infamous "hanging chad"

ballots in the 2000 Florida general presidential election). Neither Challener not McClure make any mention of generating *both* vote data *and* a computer visual representation of the voted ballot, and associating the visual representation, the vote data, and the voted ballot together based on a unique ballot identification.

The Examiner cites FIG. 9D and Col. 10, Lines 34-65 of Challener as teaching "completed vote is marked with counter key, voter key, voter ID and authenticator's key at and by a series of levels of encryptions." The Examiner's argument is fatally flawed both because the claims do not recite the feature as described by the Examiner, and because the feature of the claims most resembling the Examiner's point is not taught or suggested in Challener. The claims require marking a *voted ballot* (not a "vote" which is more analogous to the claimed vote data) with a unique ballot identification. The portion of Challener refers to a voter *encrypting* vote data in various nested levels of public and private keys to ensure accurate vote counting and no tampering. The vote data encrypted in Challener is not the same as a voted ballot. Embodiments of the present invention advantageously associate the voted paper ballot, the visual representation of the ballot, and the vote data with one another according to the unique ballot identification, to allow human beings to audit and overrule computer decisions, as described in the attached articles relating to Applicants' TrueReview system (Exhibit A).

The Examiner suggests that it would have been obvious to combine the teaching of Challener with McClure "by encrypting combined voter and ballot data because both references are electronic voting where McClure emphasizes selecting ballot to voter properly, securing voting data and eliminating errors at different voting steps, while

Challener focuses on providing a secure system to generate election result, encrypting and identifying voter, ballot and voted ballot data, and the combined teaching would have improved security and accuracy of McClure's system by facilitating the process of removing and rectifying fraudulent and challenged voted ballot."

It is clear from the above Examiner argument, that the Examiner does not understand the Applicants' invention. Put succinctly, embodiments of Applicants' invention advantageously provide the ability to audit election results by allowing humans to review and overrule computer decisions as to the intent of voters as evidenced on ballots having vote-markings made thereon. This occurs because each paper ballot is marked with a unique ballot identification, and is associated with a visual representation of the voted paper ballot, as well as the vote data that the computer determines from analyzing the visual representation of the ballot. Because of this arrangement, human election officials can very effectively audit an election:

> "The provisional ballots – their images scanned into a computer system – were projected onto a wall in the darkened room for those involved in the count to see. They include representatives from the Clinton and Obama campaigns, auditors, a caucus judge and employees of TrueBallot, the company the Democrats hired to provide election software.
>
> The provisional ballots are identified and bundled in batches so that actual ballot can be reviewed, if necessary, said Nick Koumoutseas of TrueBallot.
>
> The computer software highlights the voter's choice in green or, if the voter marks more than one candidate, it highlights the dual or triple answers in red.
>
> However, observers can see the ballot image on the screen and override the computer's choice should they discern a different voter intent, he said." (New Mexico Democrats' vote count totals don't add up, Albuquerque Tribune, February 14, 2008, attached as Exhibit A).

Simply put, nothing of the kind is taught or disclosed in the combined teachings of McClure and Challener. The cited references are not applicable beyond the top level similarity of elections and voting in general.

To be clear, nothing prevents encryption techniques, and the like, as described in McClure and Challener from being used *together with* the concepts claimed in the instant application, but these techniques do not teach or render obvious the claims of the present invention. Further, to clarify, the above story is merely exemplary, and embodiments of the present invention could audit any number of conditions, limited only by the types of vote data captured and the conditions imposed by the voting rules. Thus, identifying double or triple votes for a single candidate is only one of many possible auditing functions enabled by embodiments of the present invention.

The Examiner argues that Challener and McClure teach "generating vote data associated with each of said plurality of voted ballots based on said visual representations of said ballots." However, this is incorrect. Challener and McClure both teach generating vote data directly from paper ballots, as in the machine-readable "dots" or punched-out chads of Challener. Neither teaches scanning a paper ballot to generate a visual representation of the ballot, and then analyzing *the visual representation* to generate vote data. Furthermore, even assuming, arguendo, that the "scanners" described in the cited references make some temporary visual representation of the ballot, there is no description in either reference of generating vote data *based on the visual representation* (as opposed to directly from the machine-readable dots or holes), and certainly no teaching of "associating each visual representation and corresponding vote data with said

voted ballot based on said unique ballot identification", since neither reference teaches keeping a visual representation of the voted ballot.

The Examiner cited Challener and McClure as teaching the features of claims 25 and 36, namely, "a display device adapted to display at least one said visual representation and said vote data associated therewith." Neither Challener nor McClure teach any such feature, as described above. This rejection again demonstrates the Examiner's lack of understanding of the claimed invention, the cited references, or both. The attached news article gives a good example of displaying a visual representation of a ballot and the vote data associated therewith (voted ballot displayed on wall with selected candidate highlighted in green, or in the case of a double or triple vote, highlighted in red). The Examiner is kindly requested to reconsider and withdraw this rejection.

With regard to claims 22, 31, 32, 33 and 42, the Examiner cites McClure as teaching "modifying said vote data associated therewith." Again, this is a misinterpretation of both the claimed feature, and the teaching of McClure. As described above, and in the attached article, the vote data generated by a computer which analyzes the visual representation of the voted ballot can be overridden by a human reviewer, based on the apparent intent of the voter as evidenced by the markings on the ballot. The review and changing of selections by an internet voter described in McClure by definition happens before the ballot is voted, and therefore does not describe modifying vote data associated with a *voted ballot*.

Similarly, the Examiner cited Challener and McClure as teaching to "modify said vote data based on a review of the voted ballot associated with said unique ballot

identification in said vote data." The McClure reference was discussed above with respect to claims 22, 31, 32, 33 and 42, and that argument need not be repeated here. The portion of Challener cited by the Examiner (Col. 8, Lines 36-52 and Col. 10, Line 57 – Col. 11, Line 11) describes determining whether a cryptolope was tampered with (Col. 8), and allowing a voter to change their own vote prior to casting their ballot (Col. 10-11). This is not the same as modifying computer-determined vote data based on a review of the voted ballot associated with the unique ballot identification, and the rejection should be withdrawn.

In closing, Applicants urge the Examiner or the Examiner's supervisor to transfer this application to a new Examiner. As evidenced by the repeated improper reliance on the McClure patent (Examiner's supervisor agreed with Applicants and directed Examiner to conduct a search for new prior art – Interview conducted December 13, 2005; Pre-Appeal Brief Conference Panel withdrew Examiner's rejection – Panel Decision dated August 31, 2007), among other repeated improper rejections (§101 rejection in November 1, 2007 office action despite Panel Decision withdrawing same), the Examiner is incapable or unwilling to understand the invention and the prior art, and to either allow this application or at least cite relevant prior art. Applicants request that this application be transferred to an Examiner who will.

In view of the above, it is believed that the application is in condition for allowance and notice to this effect is respectfully requested. Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the telephone number indicated below.

Respectfully Submitted,

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Dated: March 3, 2008

Exhibit A

New Mexico Democrats' vote count totals don't add up

By Associated Press
Thursday, February 14, 2008

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The state Democratic Party's presidential caucus vote count has suffered another setback.

Party officials said Wednesday they must recheck the results of their final canvass after seeing the numbers didn't add up.

The party on Tuesday had announced what it called the "final totals" from the Super Tuesday vote — the tally of absentee and regular ballots — and posted a news release and link to them on its Web site. It removed those items after finding the statewide totals didn't match the county-by-county totals, officials said.

"If I'm uncomfortable that what I have up there is not a hundred percent accurate, I'll pull it down until I can get to that point," state Democratic Party Chairman Brian Colón said.

Democratic officials said they would recheck the final canvass numbers of regular and absentee ballots and post the correct tallies on the party's Web site. As of early this morning, the results were not yet available.

By Wednesday, the party had started counting more than 8,000 qualified provisional ballots to determine whether Hillary Clinton or Barack Obama claims victory in New Mexico.

Clinton holds the lead by more than 1,000 votes. More than 157,000 votes were cast statewide.

Kim Brace, who has focused on election administration issues for more than 30 years and is president of the Washington, D.C., company Election Data Services, questioned the state Democratic Party's ability to come up with legitimate results.

"The party itself has got egg on its face in trying to lay out a process in terms that people's voices can be heard," he said. "I don't know if you could trust whatever the election results are that they're coming up with."

Part of the problem, Brace said, is that the party is running the election, but is not bound by state electoral laws.

"It's an attempt to make it look like an election, call it a caucus, but not follow any of the rules that you have for an election," he said. "That's not the way normal elections are run."

The party has until Friday to finish the count, and Colón said he was optimistic about meeting or even beating the deadline.

About a dozen party and campaign officials were engrossed in counting the provisional ballots at an Albuquerque accounting firm Wednesday. More than 9,000 provisional ballots cast will not be counted unless they are challenged by representatives of the campaigns, Colón said.

The provisional ballots — their images scanned into a computer system — were projected onto a wall in the darkened room for those involved in the count to see. They include representatives from the Clinton and Obama campaigns, auditors, a caucus judge and employees of TrueBallot, the company the Democrats hired to provide election software.

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The provisional ballots are identified and bundled in batches so the actual ballot can be reviewed, if necessary, said Nick Koumoutseas of TrueBallot.

The computer software highlights the voter's choice in green or, if the voter marks more than one candidate, it highlights the dual or triple answers in red.

However, the observers can see the ballot image on the screen and override the computer's choice should they discern a different voter intent, he said.

Koumoutseas showed several instances of overvoting, in which voters had marked more than one name per ballot. Such ballots will not be counted. In one case, a voter had marked three choices, including Clinton, and then written "Hillary Clinton" in sprawling letters in the write-in space.

A total of 157,354 ballots — absentee, regular or provisional — were cast in New Mexico on Super Tuesday. That's a 54 percent increase from the party's first presidential caucus four years ago.

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ALBUQUERQUE -- State Democratic Party officials said they were rechecking canvassed results from the Feb. 5 presidential caucus on Wednesday, a day after they had released them on the party's Web site.

The party had announced what they termed the "final totals" of their count of absentee and regular ballots Tuesday and posted a news release and link to them on their Web site, but removed those items later that evening.

"If I'm uncomfortable that what I have up there is not a hundred percent accurate, I'll pull it down until I can get to that point," state Democratic Party Chairman Brian Colón said.

On Wednesday, the party started counting more than 8,000 provisional ballots cast in the caucus that will determine whether Hillary Rodham Clinton or Barack Obama claims victory in New Mexico.

Clinton leads by 1,121 votes. She had 68,659 votes compared with 67,538 for Obama, according to Associated Press figures based on county and absentee totals provided by the party Tuesday.

The Web site's link had been visible for about five hours Tuesday evening with what the party had said were the canvassed results before it was removed later that night. The total votes statewide did not match the party's county-by-county totals.

Democratic officials said the Web site would be updated Wednesday with vote totals that reflect the correct number of canvassed regular and absentee ballots.

Colón said the caucus results would not be final until certified by the canvass board.

"Once I certify those canvass results along with my canvass board, which is comprised of four members including me, then the numbers are final," he said. "Until then, everything is preliminary canvass results."

Kim Brace, president of Washington, D.C.-based Election Data Services, who has focused on election administration issues for more than 30 years, questioned the ability of the state Democratic Party to come up with legitimate results.

"The party itself has got egg on its face in trying to lay out a process in terms that people's voices can be heard," he said. "I don't know if you could trust whatever the election results are that they're coming up with."

Part of the problem, Brace said, is that the state Democratic Party is running the election, but is not bound by state electoral laws.

"It's an attempt to make it look like an election, call it a caucus, but not follow any of the rules that you have for an election," he said. "That's not the way normal elections are run."

The party has until Feb. 15 to finish the count, and Colón was confident with the pace of the process.

"I'm very optimistic that we will actually beat the deadline of February 15th," he said.

About a dozen party and campaign officials were engrossed in counting the provisional ballots at an Albuquerque accounting firm Wednesday. More than

9,000 provisional ballots cast were unable to be qualified, Colón said.

The provisional ballots — their images scanned into a computer system — were projected onto a wall in the darkened room for those involved in the count to see. They include representatives from the Clinton and Obama campaigns, auditors, a caucus judge and employees of TrueBallot, the company the Democrats hired to provide election software.

The provisionals are identified and bundled in batches so that the actual ballot can be reviewed, if necessary, said Nick Koumoutseas of TrueBallot.

The computer software highlights the voter's choice in green or, if the voter marks more than one candidate, it highlights the dual or triple answers in red.

However, the observers can see the ballot image on the screen and override the computer's choice should they discern a different voter intent, he said.

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A total of 157,354 ballots — absentee, regular or provisional — were cast in New Mexico on Super Tuesday. That's a 54 percent increase from the party's first presidential caucus four years ago.

The heavy turnout prompted long lines and organizers ran out of ballots at many polling sites.

Gov. Bill Richardson has said he was disappointed that party officials weren't better prepared but felt Colón did a "good job" rectifying the situation.

After the counting is completed, Richardson plans to convene a meeting of Democrats, county officials and party leaders to discuss ways to improve the process for future elections.

Several party chairs from around the state have charged that those running the caucus failed to take into account their input about where ballots should be placed and did not hold a statewide meeting of the county chairs to troubleshoot anticipated issues ahead of time.

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